

REMARKS/ARGUMENTS

The present application has been reviewed in light of the Office Action mailed May 1, 2006. Claims 1-20 are pending in the application, of which Claims 1-5, 7 and 8 have been amended and Claims 15-20 have been added herein. Reconsideration of the present application, as amended, is respectfully requested.

Allowable Claims

It is gratefully acknowledged that the Examiner has indicated that Claims 7-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Rejections Under 35 U.S.C. §102(e)

Claims 1 and 3 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Ser. No. 2006/0058783 to Buchman. Applicants submit that Claim 1, as amended herein, is allowable over Buchman.

Applicants submit that Buchman does not teach and/or suggest amended independent Claim 1. Claim 1 presently recites an electrosurgical pencil including, *inter alia*, a motion sensor disposed within and supported on the housing and in electrical connection with the source of electrosurgical energy, the sensor capable of detecting movement of the electrosurgical pencil as the electrosurgical pencil is moved freely in space and communicating a signal to the source of electrosurgical energy relating to the movement of the electrosurgical pencil, the source of electrosurgical energy supplying electrosurgical energy in response to the signal communicated from the sensor.

According to one embodiment of the present disclosure, use of electrosurgical pencil 100 includes depressing activation button 126, thereby allowing electrical energy to be transmitted to electrocautery blade 106, and moving electrosurgical pencil 100 repeatedly along the X axis (i.e., in a stab-like motion), as indicated by double-headed arrow “X” in FIG. 1, in order for accelerometer 124 to detect the motion of electrosurgical pencil 100 and transmit a corresponding signal, through control loop 116, to generator “G”. (see paragraph [0031]).

Rather, Buchman discloses an electrosurgical pencil 10 including a strain gauge 30 mounted to the surface of the proximal end 15 of blade 16. (see Buchman, paragraph [0031] and FIGS. 1-2). In operation, strain gauge 30 converts small mechanical displacements of blade 16 to electrical or optical signals. According to Buchman, the electrical signals reflect the resistance of the meter during displacement, i.e., when a metal is stretched its resistance increases or when an optical transducer is stretched its optical properties change. The measurement of the change in the resistance of the metal in the strain gauge enables the user to readily determine the degree of displacement which corresponds to the change in blade 16. (see Buchman, paragraph [0031] and FIGS. 1-2).

The overall movement, in space, of the electrosurgical pencil 10 of Buchman is inconsequential to the power being delivered by the electrosurgical pencil thereto. It is only when blade 16 comes into contact with an obstruction or when a drag force is exhibited on blade 16 that the power being delivered to electrosurgical pencil 10 is altered.

Accordingly, Buchman does not disclose a motion sensor disposed within and supported on the housing and in electrical connection with the source of electrosurgical energy and capable

of detecting movement of the electrosurgical pencil as the electrosurgical pencil is moved freely in space, as called for in Claim 1.

Applicants therefore respectfully submit that, in view of the amendments made to Claim 1 herein, and in view of the arguments presented above, that Claim 1 is allowable over Buchman.

Since Claim 3 depends directly from Claim 1 and contains all of the features of Claim 1, for the reasons presented above regarding the patentability of Claim 1, Applicants respectfully submit that Claim 3 is also patentable over Buchman.

Rejections Under 35 U.S.C. §103(a)

Claims 2-6 were rejected under 35 U.S.C. 103(a) as being unpatentable over Buchman in view of U.S. Patent 6,494,882 to Lebouitz et al. Applicants respectfully submit that dependent Claims 2-6 are each allowable over Buchman in view of Lebouitz et al. since Claims 2-6 depend, directly or indirectly, from amended Claim 1, as well as for the reasons presented above for the patentability of Claim 1.

Additionally, the Examiner relies on Lebouitz et al. for the recitation of a motion sensor to detect movement of the device. Lebouitz et al. discloses a blade 10 having a recess 20 into which is bonded a sensor element 30. (see col. 6, lines 44-45).

Each of Buchman and Lebouitz et al. disclose placement of and/or support of the “sensors” on the blade. Neither Buchman nor Lebouitz et al. disclose support of the sensor on the housing, as called for in Claim 1. Accordingly, Applicant submits that Buchman or Lebouitz et al., taken alone or in any proper combination with one another, can not render independent Claim 1, obvious.

Since Lebouitz et al. fails to remedy the deficiencies of Buchman, Applicants respectfully submit that Claims 2-6 are each therefore allowable.

Claims 1-6 and 11-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lebouitz et al. in view of U.S. Patent Appl. Ser. No. 2003/0032950 to Altshuler et al. Applicants respectfully submit that Claim 1 is allowable over Lebouitz et al. in view Altshuler et al. because Lebouitz et al. taken in any proper combination with Altshuler et al. fails to render Claim 1 obvious.

Claim 1 recites an electrosurgical pencil including, *inter alia*, a motion sensor disposed within and supported on the housing and in electrical connection with the source of electrosurgical energy, the sensor capable of detecting movement of the electrosurgical pencil as the electrosurgical pencil is moved freely in space and communicating a signal to the source of electrosurgical energy relating to the movement of the electrosurgical pencil, the source of electrosurgical energy supplying electrosurgical energy in response to the signal communicated from the sensor.

In the interest of efficiency, Applicants submit that the remarks/comments presented above with regard to the patentability of Claims 2-6 over Buchman in view of Lebouitz et al. apply with equal force here with regard to the patentability of Claim 1 over Lebouitz et al. in view of Altshuler et al.

The Examiner relies on Altshuler et al. for the teaching of a device including a motion sensor in the handpiece to send signals to control the delivery of energy based on the sensed motion of the device.

Altshuler et al. discloses, in one embodiment as seen in FIG. 18A, a photocosmetic device including a handpiece 1800 having a motion sensor 1820 for determining handpiece speed. (see paragraph [0152]). In one embodiment, a wheel 1821 is positioned to make *physical contact* with skin 1810, such that the *wheel rotates as handpiece 1800 is moved relative to the skin 1810*, and handpiece speed can be determined. (see paragraph [0152]).

Accordingly, in order for the motion sensor 1820 of Altshuler et al. to function properly, the wheel 1821 must be in contact with the skin 1810 and thus only senses motion when the wheel 1821 is displaced or rated as a result of the movement of handpiece 1800 relative to skin. Applicants submit that the motion sensor 1820 of Altshuler et al. will not detect motion of handpiece 1800 if wheel 1821 is not in contact with the skin or other suitable surface.

Therefore, Applicants submit that Altshuler et al. is an improper reference for combination with Lebouitz et al.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the Claim limitations. The teaching or suggestion to make the Claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2143 - §2143.03 for decisions pertinent to each of these criteria.

"The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). See also *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983)

Applicants submit that the combined teaching of Lebouitz et al. with Altshuler et al. does not teach or suggest amended Claim 1. As presented above, Claim 1 recites, *inter alia*, a motion sensor that is capable of detecting movement of the electrosurgical pencil as the electrosurgical pencil is moved freely in space.

Applicants respectfully submit that Lebouitz et al. is silent as to the mode of activation of the sensor thereof. Accordingly, Applicants submit that Lebouitz et al. fail to anticipate a sensor that is capable of detecting movement of the electrosurgical pencil as the electrosurgical pencil is moved freely in space, as called for in Claim 1.

Therefore, Applicants respectfully submit that Altshuler et al. fails to disclose a sensor that is capable of detecting movement of the electrosurgical pencil as the electrosurgical pencil is moved freely in space, as called for in Claim 1.

As stated above, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. Accordingly, Applicants submit that since each of Lebouitz et al. and Altshuler et al. fail to teach or suggest Claim 1, Claim 1 can not be deemed obvious over Lebouitz et al. in view of Altshuler et al.

CONCLUSION


In view of the amendments made to the Claims herein, and in view of the remarks/arguments presented above, it is respectfully submitted that each of the objections and rejections raised by the examiner in the present Office Action have been overcome. Applicants Also submit that new Claims 15-20 are allowable over the references of record.

Should the Examiner believe that a telephone interview may facilitate resolution of any outstanding issues, the Examiner is respectfully requested to telephone Applicants' undersigned attorney at the number indicated below.

Please charge any deficiency as well as any other fee(s) that may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550.

Respectfully submitted,

By:


Thomas A. Beaton
Reg. No. 46,543
Attorney for Applicants

Date: 7/21/06

United States Surgical,
a Division of Tyco Healthcare, LP
195 McDermott Rd.
North Haven, CT 06473
(303) 581-6831